

REMARKS

The amendments set forth above and the following remarks are believed responsive to the points raised by the Office Action dated July 16, 2004. In view of the amendments set forth above and the following remarks, reconsideration is respectfully requested.

Claims 1 and 13 have been amended. Claims 2 and 3 have been canceled. The amendments to claims 1 and 13 each incorporate the limitations of claims 2 and 3. No new matter has been added.

In the Office Action, claims 1-23 were rejected under 35 U.S.C. § 103 as being allegedly obvious in view of U.S. 5,552,068 (Griffith) in combination with Smalheer and/or U.S. 5,700,764 (Walters et al.). The Applicants respectfully disagree. Independent claim 1 defines a gear oil essentially free of an ashless dispersant while also meeting MIL-L-2105D (API GL-5) performance specifications and having an L-60-1 carbon/varnish rating of at least 7.5 and an L-60-1 sludge rating of at least 9.4. Independent claim 13 defines a method of manufacturing a gear oil essentially free of an ashless dispersant and wherein the gear oil meets MIL-L-2105D (API GL-5) performance specifications and has an L-60-1 carbon/varnish rating of at least 7.5 and an L-60-1 sludge rating of at least 9.4. Nothing in Griffith alone or in combination with Smalheer or Walters et al. discloses, points to, or suggests such a gear oil or method of making such a gear oil that is essentially free of an ashless dispersant and also provides clean gear performance. Griffith discloses a lubricant composition containing amine phosphate and discloses adding to this composition additives such as dispersants. (See column 4, lines 16-17). Further, Smalheer and Walters et al. likewise teach nothing about a gear oil essentially free of an ashless dispersant that also provides a clean performing gear oil. The Applicants have surprisingly found a combination of components that function together in the absence of an ashless dispersant to provide a clean performing gear oil; namely, one that meets MIL-L-2105D (API GL-5) performance specifications and has an L-60-1 carbon/varnish rating of at least 7.5 and an L-60-1 sludge rating of at least 9.4. (See, e.g., present specification page 1, lines 17-20; page 6, lines 12-16 and page 30, line 23 to page 31, line 4). Nothing in the cited references discloses or points one of ordinary skill in the art to the presently claimed invention.

Therefore, it is respectfully submitted that claims 1 and 13 are nonobvious in view of Griffith in combination with Smalheer and/or Walters et al. Further, claims 4-12 and 14-23, which are dependent upon claim 1, are also nonobvious in view of Griffith in combination with Smalheer and/or Walters et al. It is respectfully submitted that the rejections have been overcome and, therefore, should be removed.

Fees

It is believed that there are no other fees associated with this filing. However, in the event the calculations are incorrect, the Commissioner is authorized to debit the appropriate fees from the Deposit Account of the undersigned, No. 05-1372. The Commissioner is hereby authorized to charge any deficiencies associated with this communication or credit any overpayment to Deposit Account No. 05-1372. This paper is submitted in duplicate.

Conclusion

The application is considered in good and proper form for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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Date: **September 14, 2004**